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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/884,873 06/30/97 COOK

P ISIS-2202

HM12/0803

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EXAMINER

GARCIA, M

ART UNIT

PAPER NUMBER

1627

DATE MAILED:

08/03/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

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Advisory Action

Application No.

08/884,873

Applicant(s)

Cook

Examiner

Maurie E. Garcia, Ph. D.

Art Unit

1627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED Jul 23, 2001 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

THE PERIOD FOR REPLY [check only a) or b)]

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search. (See NOTE below);
- (b) ☒ they raise the issue of new matter. (See NOTE below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: Please see attached.

4. ☐ Applicant's reply has overcome the following rejection(s): _____
5. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):
- Claim(s) allowed: _____
- Claim(s) objected to: _____
- Claim(s) rejected: 2-5, 7-12, and 33
9. ☐ The proposed drawing correction filed on _____ a) has b) has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
11. ☐ Other: _____

ADVISORY ACTION
Attachment

1. Applicant's After Final amendment filed July 23, 2001 raises new issues which would require further search and consideration. Additionally, the proposed amendment adds new matter to the claims (see below). Also, the proposed amendment does not place the case in better form for appeal. Thus, for these reasons, the After Final amendment filed July 23, 2001 will not be entered and the rejections of record are maintained.

Applicant's arguments are mostly moot in view of the non-entry of the amendment. However, certain arguments are addressed below.

2. Applicant argues that the deletion from claim 33 of the limitation that T is a single bond is not new matter, and further proposes to delete another limitation from claim 33 in the After Final amendment (omitting "halo" as a substituent, see proposed claim 33 and page 8, line 21 of the amendment).

3. However, the examiner maintains that the specification as originally filed does *not* provide support for removal of these limitations. As stated previously, the claims are directed to a mixture, not a single compound. It is not apparent that applicant had support for mixtures wherein T is *not* a single bond. The same is true for the proposed removal of "halo" as a substituent limitation from claim 33 in the After Final amendment. The removal of these limitations as a selection in the Markush group is new matter because there is not support for such "sub-generic" mixtures.

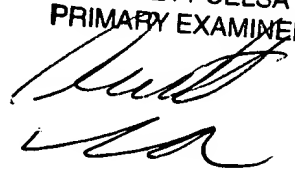
4. The issue is whether a written description of a Markush group disclosing a variety of substituent moieties can support a claim amended to recite only a subset of the originally claimed moieties. The examiner's position is that the disclosure must reasonably guide one skilled in the art to select the specific subset of moieties recited in the claims and that this guidance is *not* sufficient in the instant case.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurie E. Garcia, Ph.D. whose telephone number is (703) 308-0065. The examiner can normally be reached on Monday-Thursday and alternate Fridays from 8:30 to 6:00.

6. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jyothsna Venkat, can be reached on (703) 308-2439. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Maurie E. Garcia, Ph.D.
August 2, 2001

BENNETT CELSA
PRIMARY EXAMINER



8/2/01